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Jeff Beno

PATENT
Atty. Docket No. 30454-230

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

WILLIAM ERIC CORR

Serial No.: 09/344,169

Filed: June 24, 1999

For: DETERMINING TIMING OF INTEGRATED
CIRCUITS

Group Art Unit: 2128

Examiner: H. Jones

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks respond to the Examiner's Answer, which was filed on August 23, 2004, in the above-referenced case.

Claim and Abstract Objections

The Examiner asserts that the Claim and Abstract objections raised by the Examiner pertain to petitionable subject matter under 37 CFR 1.181, rather than appealable subject matter, citing MPEP § 1002 and 1201. In this regard, MPEP § 1201 provides as follows:

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute.

In the present case, most of the claim objections made by the Examiner directly parallel the Examiner's previous § 112 rejections, which rejections have now been withdrawn. Merely restating the same rejection as an objection does not change its essential character and, accordingly, each such claimed objection is believed to be proper appealable subject matter.

Moreover, in certain cases the Examiner's claim objections attempt to alter the scope of patent protection sought by the Appellant. For example, the Examiner's objection to the limitation "allowing a user to select a mode of operation", clearly is a disguised § 112 rejection. In addition, that objection also attempts to "deny [Appellant] the patent protection to which he or she is entitled," by requiring Appellant to amend the claim in a manner which would change the liberal scope of the claim so significantly that it likely would not cover any practical method.

Finally, although not specifically stated, it is assumed that the Abstract objections are withdrawn by the Examiner, as the grounds for those objections simply parallel certain now-withdrawn § 112 claim rejections.

Grouping of the Claims

The Examiner argues that all pending claims should be considered a single group merely because Appellant previously may not have specifically pointed out the distinctions between the prior art and certain limitations in some of the dependent claims. However, the Examiner cites no authority to support his assertion that, on appeal, Appellant is limited to making arguments that previously have been made to the Examiner, and Appellant is not aware of any such authority.

The Examiner also asserts that Appellant has “not presented any rationale or explanation for the grouping in the sections entitled ‘Grouping of Claims’ or in ‘Arguments’”. However, even a cursory review of Appellant’s Appeal Brief will indicate that this is not the case. Appellant’s “Grouping of the Claims” section clearly states that each group will stand or fall together, and the “Argument” section provides reasons why each group of claims is patentable. The Examiner has not provided even a single example to the contrary.

As pointed out by the Examiner, an exception to Appellant’s statement that each group will stand or fall together was included in the Appeal Brief. However, that exception does not in fact apply to any of the groups of claims on appeal. Accordingly, Appellant respectfully requests that such exception be deemed deleted.

Prior Art Rejections

In his Answer, the Examiner appears to simply repeat verbatim the same prior-art rejections and arguments made in the final Office Action from which the present appeal was taken. The reasons that those arguments are believed to be improper and/or inadequate were specifically set forth in Appellant's Appeal Brief. However, the Examiner does not even attempt to respond to any of the points raised by Appellant in the Appeal Brief.

In this regard, MPEP § 1208 states that "The answer should contain a response to the allegations or arguments in the brief," and that "The examiner should reevaluate his or her position in the light of the arguments presented in the brief." Furthermore, MPEP § 1208(A)(11) provides:

The examiner's answer is required to include... A statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention. If any ground of rejection is not argued and replied to by appellant, the response shall point out each claim affected.

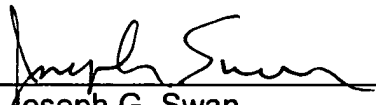
The inability to respond to the points raised by the Appellant in his Appeal Brief is believed to be fairly convincing evidence that such points are in fact valid and correct, if not an implied acquiescence by the Examiner to their validity. For the foregoing reasons, Appellant respectfully requests that all pending objections and rejections be reversed and a Notice of Allowance issued.

If there are any fees due in connection with the filing of this paper that have not been accounted for in this paper or the accompanying papers, please charge the fees to our Deposit Account No. 12-2252. If an extension of time under 37 C.F.R. 1.136 is required for the filing of this paper and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to our Deposit Account. A duplicate copy of this page is enclosed for that purpose.

Respectfully submitted,

MITCHELL, SILBERBERG & KNUPP LLP

Dated: October 13, 2004

By 
Joseph G. Swan
Registration No. 41,338

MITCHELL, SILBERBERG & KNUPP LLP
11377 West Olympic Boulevard
Los Angeles, California 90064
Telephone: (310) 312-2000
Facsimile: (310) 312-3100